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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/631,161 | 07/31/2003 | Armin Fehn | WAS 0596 PUS / Wa 10223- | 7543 |
| 22045 | 7590 | 11/15/2005 | EXAMINER | |
| BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075 | | | PENG, KUO LIANG | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,161

Applicant(s)

FEHN ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/30/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,21,28 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17,21,28 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' amendment filed on August 30, 2005 was received. Claims 1-16, 18-20, 22-27 and 29-30 are deleted. Claims 17 and 21 are amended. Claims 32-40 are added. Now, Claims 17, 21, 28 and 31-40 are pending.
2. Claim rejection(s) under 35 USC 103 in the previous Office Action (Paper No. 061105) is/are removed.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 061105).

Claim Rejections - 35 USC § 103

4. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi (EP 1 043 363) in view of Ebbrecht.

For Claims 32-33, Miyoshi discloses a silicone rubber mold obtained by curing an addition curable composition in the presence of a rhodium catalyst. The composition comprises alkenyl-containing polyorganosiloxane and hydrido-containing polyorganosiloxane. The alkenyl group can be a vinyl group. ([0002], [0010]-[0015], [0017]-[0023]) Miyoshi is silent on the use of the specific rhodium

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catalyst set forth in the instant claim. However, Ebbrecht discloses the use of rhodium catalysts in a hydrosilylation reaction. The catalysts include $\text{RhX}_3(\text{SR}^2_3)_3$, RhR^4_3 , $\text{Rh}(\text{CO})_2\text{R}^4$, etc. wherein R^4 is 2,4-pentanedionato group; X is a halogen group, preferably a chlorine group. (col. 5, lines 51-62) Note that there appears to have a typographical error in $\text{RhX}_3(\text{SR}^2_3)_3$. It should read $\text{RhX}_3(\text{SR}^3_2)_3$. The motivation of the using these rhodium catalysts is to obtain exclusively a desired 1,2-addition reaction product. (col. 6, lines 6-9) In light of the benefit mentioned, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize Ebbrecht's rhodium catalysts in Miyoshi's addition reaction. Note that "baking" in the preamble of the instant claim is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02. Applicants allege, "This phrase ["baking mold"] is not an intended use, but is a true claim limitation and describe a product, not a condition." (Remarks, page 6, last paragraph) However, it is not persuasive because a baking mold is still just a mold, and reference only needs to be capable of "baking". The "baking" part is merely a future intended use for the mold itself. Further, "baking" describes heat applied in a furnace, and does not require a food product application.

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For Claims 34-36, note that Miyoshi further discloses in the Comparative Examples, a silicone rubber mold obtained by curing an addition curable composition that does not contain any oily substance.

For Claims 37-38, note that the claim languages do not exclude the use of Rh-based catalysts.

5. Claims 17, 21, 28 and 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hompanera (US 6 197 359) in view of Ebbrecht (US 5 552 506).

For Claim 17, 21, 32-36 and 39-40, Hompanera discloses a baking mold prepared by polyaddition reaction of a methyl-vinyl-polyorganosiloxane and hydrido containing polyorganosiloxane. The baking mold can be confectionery molds or other receptacles in general. (col. 1, lines 61-67, col.2, line 65 to col. 3, line 7 and col. 3, lines 34-50) Organic colorants can be added. (col. 4, lines 23-34) Hompanera is silent on the use of the specific rhodium catalyst set forth in the instant claim. However, Ebbrecht discloses the use of rhodium catalysts in a hydrosilylation reaction. The catalysts include $\text{RhX}_3(\text{SR}^2)_3$, RhR^4_3 , $\text{Rh}(\text{CO})_2\text{R}^4$, etc. wherein R^4 is 2,4-pentanedionato group; X is a halogen group, preferably a chlorine group. (col. 5, lines 51-62) Note that there appears to have a typographical error in $\text{RhX}_3(\text{SR}^2)_3$. It should read $\text{RhX}_3(\text{SR}^3)_3$. The motivation of the using

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these rhodium catalysts is to obtain exclusively a desired 1,2-addition reaction product. (col. 6, lines 6-9) In light of the benefit mentioned, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize Ebbrecht's rhodium catalysts in Hompanera's addition reaction.

For Claims 28 and 31, since Hompanera in view of Ebbrecht's curable composition is substantially the same as Applicants' composition, Examiner has a reasonable basis to believe that both have the same appearances including transparency, color, etc. *In re Best*, 195 USPQ 430 (CCPA 1977).

For Claims 37-38, note that the claim languages do not exclude the use of Rh-based catalysts.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire

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on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp

November 10, 2005

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng
Primary Examiner
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